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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,977	06/10/2004	Lydia Breck	40655.0736	3976
66170 7590 07/08/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3691				
NOTIFICATION DATE		DELIVERY MODE		
07/08/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/709,977

Applicant(s)

BRECK ET AL.

Examiner

ANN LOFTUS

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/19/10

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed 4/21/10. The application is a continuation of 09/800,461 (US 7627531) which claims three provisionals, the earliest of which is dated 3/7/2000. Claims 1-11 are cancelled and 18-29 are new. Claims 12-29 are pending.

Response to Arguments

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

The applicant has attempted to belatedly traverse the Official Notices. The first Official Notice (if a product is purchased by redeeming an award...) was not relied upon in the last action. The second Official Notice is supported by Carrithers as cited in the rejection in the last action, and repeated below (see claims 14 and 17). However, the Official Notices remain part of the art of record because they were not adequately traversed. The traverse is not sufficient for the following reasons.

Adequate traversal is a two step process with a time limit. Both steps must be present in the response to the action containing the Official Notice in order to be timely. First, the applicant must state on the record their traversal of the Official Notice. Traversing the rejection containing the Official Notice is insufficient. Second and in accordance with 37 C.F.R. §1.111(b) which requires the applicant to specifically point out the supposed errors in the Office Action, the applicant must state *why* the Official

Notice statements are not to be considered common knowledge or well known in the art. Because the applicant's traversal is inadequate, the Official Notice statements are taken to be admitted as prior art. See MPEP §2144.03.

This Official Notice dates to the action of 1/22/08. In order to be timely, a sufficient traverse would have to be included in the response of 6/23/08. Since the applicant did not seasonably traverse the Official Notice statements from the previous Office Action, the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03. Second, the applicant merely makes general comments about the Official Notice and does not point out any reasoning that applies to the subject matter. Such a traverse is inadequate because it is late and generic.

Claim Objections

3. Claims 12-29 are objected to because of the following informalities. It appears to the examiner as if the dependencies are erroneous, based on the duplicates and patterns. The applicant is requested to check and either confirm they are as intended or amend them. New claims 19 and 28 are duplicates and both depend from claim 12. New claims 20, 23 and 29 are duplicates and also depend from claim 12.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 12, 15, and 24 recite the generation of the secondary transaction number does not use a signed digital certificate. The specification says that a disadvantage of Franklin's system is the signed digital certificate. However the specification does not describe generation a secondary transaction number that does not use a signed digital certificate. Recognition of a disadvantage in another invention is not the same as inventing a process that overcomes that disadvantage. The specification shows no evidence that the invention does not use a digitally signed certificate. The dependent claims fail to remedy the problem and are also rejected.

Further, claims 19, 22 and 28 recite that in response to authorization of the transaction, the merchant automatically requests the STN. This doesn't make sense because (claim 12 receiving ...) the STN is part of the transaction authorization request, which means the merchant already has the STN. Where is this described in the specification?

Further, claims 20, 23 and 29 recite the record of the transaction does not include the non-currency based account identifier. Where does the specification describe a profile that does not include the non-currency based account identifier? How are the boundaries of the profile determined?

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 19, 22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19, 22 and 28 recite that in response to authorization of the transaction, the merchant automatically requests the STN. This doesn't make sense because (claim 12 receiving ...) the STN is part of the transaction authorization request, which means the merchant already has the STN.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Specific findings on the level of ordinary skill in the art may be omitted if the cited prior art reflects an appropriate level and the need for testimony is not shown. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

9. Claims 12, 13, 15, 16, 18-25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5883810 filed 9/24/97 by Franklin, in view of US 5689100 filed 3/21/96 by Carrithers.

As to claims 12, 15, and 24, Franklin discloses in col 8 line 60 to col 9 line 10 generating a secondary transaction number (STN) at a remote server and wherein the STN is associated with the ("primary") account. Franklin uses a signed digital certificate to authenticate the user, but does not use it to generate the secondary transaction number. Notice that in Franklin's claims, claim 1 discloses the STN (proxy number) but the signed digital certificate does not appear until claim 4. This discloses generating a STN without using a signed digital certificate.

Franklin discloses in col 10 lines 1-5 and col 2 lines 48-55 creating a STN profile (transaction record) including information relating to a cash equivalent amount available to the STN.

Franklin discloses in col 10 lines 6-13 transmitting the STN from the remote server to the user.

Franklin discloses in col 10 lines 16-18 discloses auto-filling the STN into a transaction request provided to the merchant.

Franklin discloses in col 10 lines 38-50 receiving at the provider a transaction authorization request from the merchant wherein the transaction authorization request includes the STN.

Franklin discloses in col 11 near line 42 authorizing the transaction,

Franklin discloses in col 10 lines 1-5 recording a record of the transaction in the STN profile.

Franklin discloses in the abstract a secondary transaction number linked to a primary account, but Franklin's primary account is not a non-currency based account. Carrithers in col 6 line 60 - col 7 line 13 discloses:

- a method for facilitating a non-currency based transaction,
- identifying via a computer of the provider, a non-currency based account of the user, the non-currency based account being associated with a non-currency based program (Identifying an account is inherent in determining sufficient funds in the account).
- Converting accumulated non-currency based value in the non-currency account into a corresponding cash equivalent;
- Determining that the corresponding cash equivalent is not less than a transaction amount, the transaction amount being at least a portion of a price associated with at least one of a good or service.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Franklin to substitute Carrithers' non-currency based account for the primary account in Franklin, with predictable results and a reasonable expectation of success, in order to allow broader secure use of non-currency credits.

As to claims 13, 16, and 25 Franklin discloses designating limited use parameters and associating the limited use parameters with the STN in col 2 lines 48-55.

As to claims 18, 21 and 27, Franklin discloses in col 8 lines 57-62 and col 10 near line 56 authenticating a user and a merchant with a provider.

As to claims 19, 22 and 28, Franklin discloses the merchant automatically requesting an STN (credit card number) in col 8 lines 30-37.

As to claims 20, 23 and 29, the contents of the record of the transaction are non-functional descriptive material since it is not functionally related to the other steps, but rather merely inert stored data. Franklin discloses a transaction record with an STN profile in col 10 lines 1-5, and fig 4. Franklin discloses in col 11 lines 61 to 67 a daily interchange file of transaction data from the merchants. This transaction data would only include the STN, since the merchant does not have access to the non-currency based account identifier. Thus Franklin discloses a record of the transaction that does not include the non-currency based account identifier. It would have been obvious to a person of ordinary skill in the art at the time of the invention with predictable results and a reasonable expectation of success to modify Franklin's STN profile to remove the non-currency based account identifier and store the cross referencing data somewhere else, in order to make the cross referencing faster.

10. Claims 14, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin, in view of Carrithers as filed above, further in view of Official Notice.

As to claims 14, 17 and 26, Franklin teaches a settlement process in col 11 lines 45 to col 12 line 9. Franklin does not teach the details of the settlement.

Carrithers teaches creating a file and routing it as posting a transaction, where file is interpreted as any collection of electronic data. Carrithers teaches in col 9 lines 1-61 capturing transaction settlement information in a financial capture system, in claim 12 creating an accounts payable file and routing the accounts payable file to an accounts payable system for payment processing, and in col 9 lines 1-61 forwarding the transaction settlement information to an accounts receivable system (billing). Carrithers thus supports the Official Notice, now admitted prior art, that the following was old and well-known at the time of the invention:

- o Capturing transaction settlement information in a financial capture system
- o creating an accounts payable file and routing the accounts payable file to an accounts payable system for payment processing
- o Forwarding the transaction settlement information to an accounts receivable system.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Franklin to add these limitations in order to use generally accepted accounting terminology and practices for settlement.

Franklin discloses recognizing that that the settlement information includes the STN in col 12 lines 1-9.

Franklin does not disclose, but Carrithers does in col 9 lines 25-35 issuing a credit from the non-currency based account to the accounts receivable system, wherein the credit from the non-currency based account offsets at least part of the transaction amount. It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify Franklin to add this limitation in order to allow broader secure use of non-currency credits.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

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